

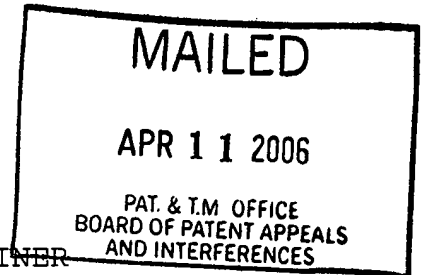
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

Ex parte JOHN C. HARVEY and JAMES W. CUDDIHY

Application 08/470,571

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER



This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on January 30, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing are identified below.

On January 30, 1996, February 1, 1996, April 5, 1996, April 7, 1997, November 19, 1998, August 11, 2000, May 11, 2001, January 28, 2002, March 5, 2002, March 18, 2002, June 18, 2002, February 7, 2003, and May 5, 2003, appellants filed Information Disclosure Statements (IDSs). It is not clear from the record

whether the examiner considered the IDSs or whether the examiner notified appellants of why their submissions did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

A review of the file indicates that on February 8, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on February 8, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) **Summary of claimed subject matter.** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(ix) **Evidence appendix.** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

An in-dept review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed February 8, 2005:

1. "Summary of claimed subject matter," as set forth in 37 CFR § 41.37(c)(1)(v); and
2. "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix).

It is required that a substitute Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

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Accordingly, it is ORDERED that the application is return to the Examiner to:

- 1) consider the Information Disclosure Statements filed January 30, 1996, February 1, 1996, April 5, 1996, April 7, 1997, November 19, 1998, August 11, 2000, May 11, 2001, January 28, 2002, March 5, 2002, March 18, 2002, June 18, 2002, February 7, 2003, and May 5, 2003;
- 2) provide appropriate written notification by the examiner to appellants of such consideration;
- 3) to have a copy of the consideration of the Information Disclosure Statements scanned into the record;
- 4) hold the Appeal Brief filed on February 8, 2005, defective;
- 5) to notify appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCE

A handwritten signature in black ink, appearing to read 'Dale M. Shaw', is written over a horizontal line.

DALE M. SHAW
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DMS/pgc

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